

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q62820

Naoyuki ORII, et al.

Appln. No.: 09/769,392

Group Art Unit: 2155

Confirmation No.: 4710

Examiner: Bharat Barot

Filed: January 26, 2001

For: SYSTEM, METHOD AND STORAGE MEDIUM FOR DISTRIBUTING  
INFORMATION USEFUL IN SPECIFIC AREA TO PORTABLE TERMINALS

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**MAIL STOP AF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated July 3, 2006, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

As of the final rejection, dated July 3, 2006, claims 15, 17-19 and 22 are rejected under 35 U.S.C. § 101, claims 3, 5-6, 9, 11-12, 15, 17-19, 22, and 25 are rejected under 35 U.S.C 102(e) as allegedly being anticipated by U.S. Patent No. 6,813,608 B1 to Baranowski et al ("Baranowski"), and claim 19 is rejected under 35 U.S.C 103(a) allegedly being unpatentable over Baranowski.

Regarding the rejections under 35 U.S.C. § 101, Applicant canceled claim 22, without prejudice or disclaimer, and amended claim 15 in the October 3, 2006 Amendment. In the

October 16, 2006 Advisory Action, the Examiner indicated that the amendments overcome the rejections under 35 U.S.C. § 101 (and would be entered for purposes of appeal). Accordingly, Applicant submits that the rejections under 35 U.S.C. § 101 are now moot.

Applicant now turns to the prior art rejections.

**A. Claim 3**

Applicant submits that claim 3 is patentable over the cited reference. For example, claim 3 recites that “a terminal located in a store in the shopping mall operative to register in advance first information on the shopping mall, second information on the shopping mall.....regarding each store in the shopping mall requesting its distribution”. Further the system comprises “*a means for distributing, .....the items.....out of the first information, to a portable terminal of the customer perceived to be visiting said shipping mall and for distributing the second information, differing from said first information, to portable terminals of customers not perceived to be visiting said shopping mall*”.

In the system according to the present invention, the information to be distributed may either be extra-specific area information useful for urging customers outside the shopping mall to come shopping or intra-specific area information useful for customers within the shopping mall to come shopping and the two types of the information are registered as differentiated from each other (non-limiting embodiment, page 9 lines 18-24 of specification). Thus, the present invention can provide an information distribution system without the problem of the *conventional system* in which the conventional system, “distributes information for mobilizing

customers... *irrespective of where the individual customers are*" (emphasis added) (Page 1 lines 10-15 of specification).

The claimed second information is 1) registered by the terminal in a shopping mall and 2) distributed to portable terminals of customers, not perceived to be visiting said shopping mall. Applicant submits that Baranowski fails to disclose the second information. For example Baranowski discloses a web host which display merchandise for sale and take purchase orders. The merchandise can then be shipped to the customer, held for pick-up when the customer visits the wide-area facility or delivered to the accommodations of the customer within the wide-area facility at a specific time (Figures 1-5, Col. 14 lines 17-28). The web host, however, distributes the information *irrespective of where the customer is*. The information is only distributed based on the customer's selection of the merchandise or order placement; the system does not pay any attention to the customer's location before sending the information. A customer can access the web host at home or while in a mall, and the information will still be the same.

Further Baranowski discloses that the web host distributes the information which may include reviews or information about the attractions of the wide-area facility, particularly those that the customer made reservations for. This information may also include weather forecasts for the day of the customer's planned visit to the wide-area facility, industry news relevant to the wide-area facility and similar facilities, or any other information that may be useful to the customer (Figures 1-5, Col. 15 lines 21-31) Similar to Applicant's comments above, however, the web host of Baranowski distributes the information *irrespective of where the customer is*. It distributes the information based only on the customer's *reservation* and does not pay any

attention to the customer's current location at the time of distributing the information. For example, the customer may make reservations for the next visit while the customer is still currently visiting the wide-area facility.

At least based on the foregoing, Applicant submits that claim 3 is patentable over Baranowski.

In the October 3, 2006 Amendment, Applicant requested the Examiner to point out the alleged "second information" in a more precise manner if the rejection of claim 3 was to be maintained. The Examiner did not provide the requested information in the attachment to the October 16, 2006 Advisory Action. For purposes of appeal, such information is respectfully requested if the rejections are to be maintained.

**B. Claims 9, 15 and 25**

Since claims 9, 15 and 25 contain features that are analogous to the features recited above for claim 3, Applicant submits that such claims are patentable for at least analogous reasons as claim 1.

**C. Claims 5-6, 11-12 and 17-19**

Since claims 5-6, 11-12 and 17-19 are dependent upon one of claims 3, 9 and 15, Applicant submits that such claims are patentable by virtue of their dependency.

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U.S. Application No.: 09/769,392

Attorney Docket No.: Q62820

**D. Claim 22**

Since Applicant has canceled claim 22, without prejudice or disclaimer, Applicant submits that the rejection of such claim is now moot.

Respectfully submitted,



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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: December 4, 2006 (since December 3, 2006 fell on a Sunday)

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number Q62820	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	09/769,392	January 26, 2001	
	First Named Inventor		
	Naoyuki ORII		
	Art Unit	Examiner	
	2155	Bharat Barot	
<p style="text-align: center;">WASHINGTON OFFICE <b>23373</b> CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record. Registration number    25,665</p> <div style="text-align: right;">         Signature        Reg. # 39,283        For     </div> <div style="text-align: right;">       Howard L. Bernstein        Typed or printed name     </div> <div style="text-align: right;">       (202) 293-7060        Telephone number     </div> <div style="text-align: right;">       December 4, 2006 (since December 3, 2006 fell on a Sunday)        Date     </div>			